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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,539	07/16/2003	Manfred Ostertag	13905-042001	8440
32864 7590 04/02/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LIN, WEN TAI	
			ART UNIT 2154	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/620,539

Applicant(s)

OSTERTAG ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.
3. The examiner would like to clarify certain points that Applicant made in the remarks filed on 2/20/2007 regarding the telephone interview held on February 1, 2007. Applicant is reminded that the context of the conversation was about clarifying the phrase "implicit data" and finding ways to overcoming the prior art (Olivier) in view of the previous office action, wherein the examiner construed the term "implicit data" as information source such as emails (see paragraph #2 of the previous Final Rejection). Applicant's representative then argued that Olivier's email (such as Figure 9) was only an alternative way of providing profile information similar to the one entered at the time of registration. That's why the examiner suggested to add the clause "not originally created for establishing the dynamic target group." The examiner commented that by such a change it would overcome the current rejection, meaning that the use of Olivier's email feature would be overcome. This is very different from Applicant's statements: "It was agreed that, after these amendments, the claims are not anticipated or suggested

by the reference relied on in the office action.” (See Remarks on page 1) and “[T]he Examiner agreed in the interview that with the present amendments of the claims, including the amendment proposed by the Examiner, the claims are no longer anticipated or suggested by Olivier.” (See Applicant’s Remarks on page 2).

Applicant is further reminded that during the same interview the examiner asked Applicant’s representative to find supports from the specification for the added clause. However, based on the passages listed in the Remarks, it appears that the specification does not support the added clause. Consequently the involved claims are rejected under U.S.C. 112 first paragraph for adding new matter into the claims.

On the other hand, the passage at paragraph 53 of Applicant’s specification: “information that infers, but does not directly state, interest, expertise or responsibility of an individual regarding a certain subject” appears to be sufficient to overcome the email feature of the current prior art if Applicant made it into the claim languages to clarify the implicit data source.

4. Claims 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (see the reasons described in paragraph 3 above).

Claim Rejections - 35 USC § 102

5. Claims 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Olivier [U.S. Pat. No. 6480885].

6. Olivier was cited in the last office action.

7. As to claim 1, Olivier teaches the invention as claimed including: a method of mining human capital information, the method comprising:

receiving user input specifying criteria of association with a dynamic target group by defining one or more attributes of a communication group [e.g., col.8 line 66 – col.9 line 13 and Fig. 4; i.e., defining neighborhood to each subscriber require dynamic target grouping];

identifying individuals of the dynamic target group by searching at least one implicit data sources according to the defined attributes [258, 234, Figs.2 and 4-5; col. 10 lines 43-59; and col.6, lines 34-53, wherein user profile may be obtained via email message and/or an inference engine];

communicating with identified individuals of the dynamic target group [e.g., 238, Fig.2];

logging at least some of the communications; and analyzing the logged communications [col.3, lines 23-32 and 57-60; Abstract, lines 15-17].

8. As to claim 2, Olivier further teaches saving the defined attributes [i.e., the attributes forming each group must be saved otherwise the match servers of Fig.7 would not know what to match].

9. As to claim 3, Olivier further teaches communicating with the identified individuals of the dynamic target group includes sending to the identified individuals of the dynamic target group an information request based on at least one of a survey and a questionnaire [e.g., in response to an email of Figs. 8-9].

10. As to claim 4, Olivier further teaches generating a report based on a result of analyzing the logged communications [e.g., col.3, lines 57-60; i.e., report on each subject as individualized archive].

11. As to claim 5, Olivier further teaches accessing an enterprise planning system to identify individuals of the dynamic target group [e.g., Figs. 2 and 3B, wherein Fig.2 illustrates a planning system that is carried out by a system resource of Fig.3B; see also the interpretation of the term "enterprise resource planning system" in paragraph 2 of this office action].

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12. As to claim 6, Olivier further teaches sending information to a member of the dynamic target group triggered on an occurrence of a life or work event associated with a member [see the example of Fig.8].

13. As to claim 7, Olivier further teaches defining attributes includes defining attributes based on at least one of special knowledge area, work experience, academic experience, position, and work situation associated with the dynamic target group [col.17, lines 7-14; col.18, lines 5-17].

14. As to claim 8, Olivier further teaches communicating occurs over at least one of a computer network, wireless, the Internet, an Intranet, electronic-mail and voice-mail [Abstract].

15. As to claim 9, Olivier further teaches communicating includes sending to the identified individuals of the dynamic target group at least one of structured communication [e.g., 524 of Fig.9 is structured communication] wherein possible responses to queries are predefined and unstructured communication wherein possible responses to queries are not predefined [i.e., by default reply to question at 526 of Fig.9 (after satisfying matching criteria) is unstructured and not predefined].

16. As to claim 10, Olivier further teaches that communicating includes distributing information to the identified individuals of the dynamic target group, and receiving feedback from the identified individuals of the dynamic target group [Abstract].

17. As to claim 11, Olivier further teaches providing an enterprise with an ability to make decisions based on a result of analyzing the one or more logged communications [col.3, lines 57-60; col.17, lines 21-27; i.e., filtering uncorrelated material (including spasm) is a decision making process based on what's in the archive].

18. As to claim 12, Olivier further teaches that identifying the individuals further comprises searching at least one explicit data source and wherein searching the explicit data sources includes searching data sources having explicitly defined attribute information [e.g., col.6, lines 34-53; col.9, lines 18-29; i.e., explicit data is entered as a user's profile through registration].

19. As to claim 13, Olivier further teaches that searching implicit data sources includes searching data sources having implicitly defined attribute information [e.g., col.16, lines 56-66; i.e., attributes specified in an email requiring additional processing are thus indirectly obtained].

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20. As to claims 14-18, 19-20, 22-31, 32-33, 35-40, 44, 56 and 68, since the features of these claims can also be found in claims 1-5 and 6-13, they are rejected for the same reasons set forth in the rejection of claims 1-5 and 6-13 above.

21. As to claim 41-42, Olivier further teaches generating and updating a distribution list of the target group at the time information is exchanged with the target group [e.g., col.25, lines 1-11; col.23, lines 26-50; i.e., in a chat or game setting, updating the list is inherently required because members come and go]

22. As to claims 43, 45-46, 48-55, 57-58, 60-67, 69-70 and 72-75, since the features of these claims can also be found in claims 14, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42, they are rejected for the same reasons set forth in the rejection of claims 14, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42 above.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

March 28, 2007


3/28/07